

*Appl. No. 09/724,755
Response to Office Action of Sept. 16, 2005*

Case No. 4448D1

REMARKS

For additional clarity, claims 136 and 141 have been modified in a manner consistent with previously presented claim 131. Specifically, it is now noted in claims 136 and 141 that the plurality of different amplification products “[] have been amplified from a plurality of different loci.” Support for this amendment can be found for example on page 43, lines 13-18 of the originally filed application. This amendment is fully supported by the originally filed specification and adds no new matter.

Support for the amendment to claims 131, 136, and 141, “the addressable support-specific portion is not complementary with the different loci”, can be found for example on page 40, lines 4-5 of the originally filed application. This amendment is fully supported by the originally filed specification and adds no new matter.

Support for the amendment to claims 131, 136, and 141, “and the addressable support-specific portion is 15-35 nucleotides in length”, can be found for example on page 20, lines 5-6 of the originally filed application. This amendment is fully supported by the originally filed specification and adds no new matter.

Support for the amendments to claims 131, 141, and 146 that specify that the tail is a “hydrophilic non-nucleic acid polymer”, can be found for example on page 54, lines 10-22 of the originally filed application. This amendment is fully supported by the originally filed specification and adds no new matter.

Rejection Under 35 U.S. C. §102

The Examiner rejects claims 131-144 under 35 U.S.C. 102(b) as being anticipated by Whitcombe et al (GB 2,312,747), hereafter “Whitcombe”.

In order for a reference to anticipate a claimed invention, it must contain each element of the claim invention. Independent claims 131, 136, and 141 now include the element “hydrophilic non-nucleic acid polymer.” Whitcombe does not contain this element of applicants’ claimed invention. For at least this reason, claims 131, 136, and 141 are believed to be novel in light of Whitcombe. Further, dependant claims 132-135, 137-140, and 142-144, since based on novel independent claims, are also believed to be novel in light of Whitcombe. Thus, applicants respectfully request reconsideration, and withdrawal of the 102(b) rejection of claims 136-144.

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Rejection Under 35 U.S.C. §103

The Examiner rejects claims 131-135 and 141-145 under 35 U.S.C. §103 as being unpatentable over Jenkins (APMIS (1991) 99:667-673) in view of Grossman et al (US Patent 5,514,543), hereafter "Jenkins" and "Grossman". In order for a combination of references to render a claimed invention obvious, they must contain each element of the claimed invention. Independent claims 131 and 136 now include the element "wherein the addressable support-specific portion is not complementary with the different loci, and the addressable support-specific portion is 15-35 nucleotides in length".

In Examiner's Action, it is pointed out that Figure 1 of Jenkins shows amplification products including a distinct HPV region. *Id.* at Page 7, (c). The Examiner then creatively suggests that these distinct HPV regions are analogous to the "addressable support-specific portion" of the presently claimed invention. In light of applicants' amendments to claims 131 and 136, arguing this point directly is moot. (Applicants decision to not argue this point in no acquiesces to it.) In any case, applicants' addressable support-specific portions now have the element that they are not complementary with the different loci, and that they are 15-35 nucleotides in length. The HPV sequences in Figure 1 of Jenkins, to which Examiner refers, do not have these features.

Grossman does not remedy these deficiencies in Jenkins. Grossman does not teach addressable support-specific portions that have the characteristics of not being complementary with the different loci, and which are 15-35 nucleotides in length.

For at least these reasons, claims 131 and 136 are believed to be non-obvious in light of Jenkins in view of Grossman. Further, dependant claims 132-135, and 137-140, since based on non-obvious independent claims, are also believed to be non-obvious in light of the combination of Jenkins and Grossman. Thus, applicants respectfully request reconsideration, and withdrawal of the §103 rejection of claims 131-135 and 137-140.

CONCLUSION

Applicant respectfully asserts that the application is in condition for allowance and requests issuance of a Notice of Allowance. If the Examiner does not consider the application

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to be in condition for allowance, applicant requests that he call the undersigned at (650) 554 3392 to set up an interview.

PETITION FOR EXTENSION OF TIME AND FEE AUTHORIZATION

A petition for a 3-month extension of time is being transmitted concurrently. Should any extension of time and/or fee be necessary for timely submission of this paper, such extension of time is hereby requested. The Commissioner is authorized to charge Deposit Account No. 01-2213 (4448). Any deficiency or overpayment should be charged or credited to this deposit account.

Respectfully submitted,

Date: 3-15-06

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